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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,043	09/17/2003	Satoshi Hiratsuka	393032040800	4480
7590 David L. Fehrman Morrison & Foerster LLP 555 W. 5th Street Los Angeles, CA 90013		01/10/2008	EXAMINER FEARER, MARK D	
			ART UNIT 2143	PAPER NUMBER
			MAIL DATE 01/10/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/665,043

Applicant(s)

HIRATSUKA, SATOSHI

Examiner

Mark D. Fearer

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

- Applicant's Amendment filed 23 October 2007 is acknowledged.
- Claims 5 and 10 have been amended.
- Claims 11-14 are new.
- Claims 1-14 are pending in the present application.
- This action is made FINAL.

Claim Objections

Claim 5 is objected to because of the following informalities: "computer-readable" medium is not disclosed in the specification. For purposes of examination, claim 5 was examined as storage medium. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasegawa et al. (US 6928261 B2) in view of Nishimoto et al. (US 20020000156 A1).

Consider claims 1, 5, 6 and 10-14. Hasegawa et al. discloses a content delivery apparatus comprising a storage section that stores content material to be delivered to a client terminal ((“According to one aspect of the present invention, there is provided a music data distribution system for distributing music data to an external device connected to a network, comprises: a storage device that stores first music data; a receiver that receives a music data distribution request from the external device connected to the network, the music data distribution request comprising at least music data identification information and music data quality information; a reading device that reads the first music data from said storage device in accordance with the music data identification information; a quality converter that converts the first music data into second music data ...”) Hasegawa et al., column 2 lines 3-14); a client terminal identification section that determines a type of a client terminal to which content is to be delivered ((“The music data request information RI and terminal information TI are integrated as one data block as shown in FIG. 5. The music data request information to be entered by the user contains the information for identifying music data desired to be downloaded, such as a music program name and a singer name of the music data. The terminal information TI is stored beforehand in ROM 12 or the external storage unit 16 of the user terminal 4, and contains the information for identifying the product type of the user terminal 4, such as the product type name specific to the user terminal 4.”)

Hasegawa et al., column 6 lines 31-41); a first content creation section that, on the basis of a determination, by said client terminal identification section, that said client terminal to which content is to be delivered is of a type capable of using said first content material of said first format, creates single composite content to be delivered to said client terminal which includes said first content material of said first format and said second content material ((“According to another aspect of the invention, there is provided a music data distribution system for distributing music data to an external device connected to a network, comprises: a storage device that stores first music data; a receiver that receives a music data distribution request from the external device connected to the network, the music data distribution request comprising at least music data identification information and device identification information; a searching device that searches the first music data from said storage device in accordance with the music data identification information; a quality determiner that determines a quality of said music data which can be reproduced by said external device; and a transmitter that transmits information displayed on a display of said external device for promoting purchase of said music data with the quality determined by said quality determiner to said external device.”) Hasegawa et al., column 2 lines 19-35); a second content creation section that, on the basis of a determination, by said client terminal identification section, that said client terminal to which content is to be delivered is of a type incapable of using said first content material of said first format, converts said first content material of said first format into a first content material of a second format capable of being used by said client terminal and then creates single composite content

to be delivered to said client terminal which includes the converted first content material of said second format and said second content material ((“... a quality converter that converts the first music data into second music data having a quality different from the first music data in accordance with the music data quality information; ...”) Hasegawa et al., column 2 lines 13-16); and a content delivery section that delivers, to said client terminal, the composite content created by said first content creation section or said second content creation section ((“... and a transmitter that transmits the first or the second music data to the external device in accordance with contents of the music data distribution request.”) Hasegawa et al., column 2 lines 16-18).

However, Hasegawa et al. fails to explicitly show a first and a second content data, or encrypting content. Nishimoto et al. discloses music data as either scores or pieces. This reads on “... at least one first content material and at least one second content material ... said first content material being of a predetermined first format.” ((“... musical composition information of a single music piece with the received melody information used as a motif thereof; other melody information made by modifying the received melody information; information made by converting waveform data of the received melody information into tone-generator driving information of a predetermined format; and musical score picture information corresponding to at least one of the information listed above.”) paragraph 0037). Nishimoto et al. further discloses encrypting data ((“Further, the data to be communicated in the present invention may be of any desired format. For example, the music piece data may be based on the MIDI standard (e.g., SMF: Standard MIDI File) or other format (e.g., format specific to the

maker or manufacturer). The musical score data may be image data (e.g., bit map), may be of any other suitable format (e.g., file format capable of being handled by predetermined score-creating or score-displaying software), may be electronic data, or may be printed on a sheet of paper or the like; if the musical score data are electronic data, they may be either in a compressed form or in a non-compressed form. Furthermore, the data may be encrypted or imparted with an electronic signature. Moreover, the data format of content may be selected as desired by the user, and data of a plurality of formats may be delivered simultaneously.”) paragraph 0137).

Therefore, it would have been obvious for a person of ordinary skill in the art at the time the invention was made to incorporate musical pieces and musical scores and encrypting data as taught by Nishimoto et al. with first and second content data stored in a storage device as taught by Hasegawa et al. for the purpose of interactive multimedia.

Consider claims 4 and 9, and as applied to claims 1 and 6 above. Hasegawa et al., as modified by Nishimoto et al., discloses a content delivery apparatus comprising: a storage section that stores a plurality of the first content materials and a plurality of the second content materials (“A music data distribution apparatus connected to a network for distributing music data to an external device, the apparatus comprising: a storage device that stores a plurality of music data;”) Hasegawa et al., column 14 lines 37-40), and wherein at least one first content material and at least one second content material to be delivered to said client terminal are read out from said storage section in response

to a request made by said client terminal ((“ According to one aspect of the present invention, there is provided a music data distribution system for distributing music data to an external device connected to a network, comprises: a storage device that stores first music data; a receiver that receives a music data distribution request from the external device connected to the network, the music data distribution request comprising at least music data identification information and music data quality information; a reading device that reads the first music data from said storage device in accordance with the music data identification information; a quality converter that converts the first music data into second music data having a quality different from the first music data in accordance with the music data quality information; and a transmitter that transmits the first or the second music data to the external device in accordance with contents of the music data distribution request.”) Hasegawa et al., column 2 lines 3-18).

Consider claims 2 and 7, and as applied to claims 1 and 6 above. Hasegawa et al. discloses a content delivery apparatus wherein said first content material and second content material is delivered to a client in a predetermined format. However, Hasegawa et al. fails to teach of the data comprising musical format. Nishimoto et al. discloses a music data distribution system comprising musical pieces and scores. This reads on “A content delivery apparatus wherein said first content material is musical score data, and said second content material is music piece data.” (“Outlining the fourth aspect, the content information created by the processor device and having the additional value imparted thereto includes at least one of: harmony information matching with the

received melody information; backing information matching with the received melody information; left-hand performance information matching with the received melody information, with the received melody information assumed to be performance information generated through a performance on a keyboard-based musical instrument by a right hand; both-hand performance information matching with the received melody information; performance expression information for the received melody information; musical composition information of a single music piece with the received melody information used as a motif thereof; other melody information made by modifying the received melody information; information made by converting waveform data of the received melody information into tone-generator driving information of a predetermined format; and musical score picture information corresponding to at least one of the information listed above.”) paragraph 0037).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate a music data distribution system as taught by Nishimoto et al. with a content delivery apparatus as taught by Hasegawa et al. for the purpose of electronic file delivery.

Consider claims 3 and 8, and as applied to claims 2 and 7 above. Hasegawa et al. discloses a content delivery apparatus wherein said first content material and second content material is delivered to a client in a predetermined format. However, Hasegawa et al. fails to teach of data comprising musical format wherein musical pieces and musical scores correspond. Nishimoto et al. discloses a music data distribution system

comprising musical pieces and scores that correspond with each other. This reads on "A content delivery apparatus as claimed in claim 2 wherein the musical score data and the music piece data correspond to each other in musical contents." ("On the "Parameter 2" input screen of FIG. 6, the user enters various parameters necessary for creating music piece data of the left-hand performance part in response to the selective designation on the "Parameter 1" input screen of FIG. 5. In the illustrated example of FIG. 6, selections have been made for setting the difficulty level to the "Beginner's Level" and the rendition style to "Arpeggio" and for imparting "Intro" and "Ending" sections to the melody. In response to the selections on the "Parameter 2" input screen, the server 3 is caused to create music piece data and corresponding musical score data of the beginner's level in such a way that an arpeggio is imparted as the rendition style and intro and ending sections are imparted to the melody.") paragraph 0074).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate corresponding musical pieces with musical scores as taught by Nishimoto et al. with a content delivery apparatus as taught by Hasegawa et al. for the purpose of multimedia content.

Response to Arguments

Applicant's arguments filed 23 October 2007 with respect to claims 1-14 have been considered but they are not persuasive.

Applicant argues that "neither Hasedawa nor Nishimoto contain any disclosure of determining format compatibility of a client device, converting a first content file in accordance with such a determination, and then combining the first content file with a second content file to make a single composite file, and delivering the single composite file to the client device."

Examiner respectfully disagrees with Applicant's argument and interpretation of Hasedawa et al.

Hasedawa et al. discloses a method of converting downloadable music files into formats that will satisfy the requesting terminal "As will be later detailed, when the music data is downloaded, the management server 2 can convert the file format of stored music data into the file format reproducible at the user terminal, and can change the contents or information amount (quality) of music data so as to satisfy user desire." column 3 lines 40-45.

Hasedawa et al. discloses a method of combining music data with requesting terminal information and sending it to a reception unit "A user inputs the music data request information RI from the input unit 26 of the user terminal 4. The music data request information input from the input unit 26 is sent to the music data request unit 28. The music data request unit 28 reads the terminal information TI specific to the terminal stored beforehand in the terminal information storage unit 27, and transmits it together with the input music data request information RI to the management server 2 via the network 3. On the management server 2 side, the music data request reception unit 33 receives the transmitted music data request information RI and terminal information TI.

By referring to the music data request information RI, the music data request reception unit 33 checks whether the original music data MO corresponding to the music data request information RI is stored in the music data storage unit 32. If the original music data MO corresponding to the music data request information RI is not stored, this effect is notified to the user terminal 4." column 11 lines 34-53.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any response to this Office Action should be faxed to (571) 273-8300 or mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Mark Fearer whose telephone number is (571) 270-1770. The Examiner can normally be reached on Monday-Thursday from 7:30am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Nathan Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

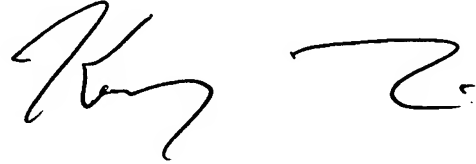
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 571-272-4100.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

Mark Fearer
M.D.F./mdf
December 27, 2007

A handwritten signature in black ink, appearing to read 'Mark Fearer', followed by a horizontal line and a small flourish.